

### **REMARKS**

The Non-Final Office Action (hereinafter the Action) mailed March 10, 2006 has been reviewed and these remarks are responsive thereto. Claims 1-45 remain pending in this application and currently stand rejected. Claims 1, 9, 30, and 38 have been amended. No new matter is added.

#### ***Claim Rejections Under 35 U.S.C. §112***

The Action rejected claims 1, 30, and 38 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 30 have been amended to correct the antecedent basis error for “the location”. Claim 38 includes in line 6 the antecedent basis for “the other location.” Applicants respectfully submit that amended claims 1, 30, and 38 comply with 35 U.S.C. § 112, second paragraph and are allowable as amended.

#### ***Claim Rejections Under 35 U.S.C. §101***

The Action rejected claims 9-16 under 35 U.S.C. § 101 because the claimed invention is not tangibly embodied as to be executable. Claim 9 has been amended to clarify the subject matter. Applicants respectfully submit that amended claim 9, and its dependent claims 10-16 comply with 35 U.S.C. § 101, and are allowable as amended.

#### ***Claim Rejections Under 35 U.S.C. §103***

(1) The Action rejected claims 1, 9, 30, and 38 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publication No. 2004/0243574 to Giroux, *et al.* (hereinafter *Giroux*) in view of U.S. Publication No. 2002/0091776 to Nolan, *et al.* (hereinafter *Nolan*). The Applicants respectfully traverse the rejections.

Amended claim 1 recites, inter alia, “comparing the first set of format attributes with the second set of format attributes, and applying to the portion of content those format attributes of the second set of format attributes that differ from the first set of format attributes in response to placing the portion of content at a location within the electronic document.”

*Giroux* teaches a method and system for moving personal information over computer networks. (*Giroux*, para. 1) More specifically, *Giroux* discloses accessing information at a source such as personal computers, personal digital assistants, or cellular phones, via a GUI, and extracting and copying the information to a destination, such as the same types of devices. (*Giroux*, para.’s 46 and 47)

Furthermore, *Giroux* recites “the received data may arrive in web pages which could include text, graphics, audio files, executable applets, data files or attachments such as software files, or other data and files known in the art. Therefore, at step 440, personal information is then parsed from the downloaded data. The format and structure of the data is derived from combinations of context and knowledge of the layout of the data as it is presented by the old Email ASP server. The layout of the data might be compared with known templates for known Email ASPs to simplify and improve the speed and accuracy of the interpretation of the data.” (*Giroux*, para. 67)

None of the example methods of parsing described by *Giroux* in paragraphs 69 – 72 include “determining a second set of format attributes associated with a second region of content for the electronic document”, “comparing the first set of format attributes with the second set of format attributes”, and “applying to the portion of content those format attributes of the second set of format attributes that differ from the first set of format attributes”, as recited by amended claim 1. Thus, *Giroux* does not teach or suggest the elements of amended claim 1. In fact, *Giroux* is directed to a different subject matter.

*Nolan* teaches a method for handling email in a processing assembly. (*Nolan*, para. 13) *Nolan* also does not teach or suggest the elements of amended claim 1, as recited above. In fact, *Nolan* refers to prior art disclosing converting a document having a first format to another document having a second format. However, the method described by *Nolan* includes a user

preference table with entries identifying formats preferred by a user. This is completely distinct and different from the method claimed by the Applicants in amended claim 1.

Thus, *Giroux* and *Nolan* fail to teach or suggest individually or in combination features of the Applicants' amended claim 1. Amended claim 1 is therefore in condition for allowance, and notice to that effect is respectfully requested.

Amended claim 9 recites a system for determining and applying one or more format attributes to content in an electronic document, where components of the system execute tasks with similar features to those recited in amended claim 1. Amended claim 30 includes similar feature as in amended claim 1 with at least one distinction being placement of the portion of content at a location of a second electronic document. Amended claim 38 recites a computer-readable storage device storing a set of computer-executable instructions implementing a method with similar features to amended claims 1 and 30. Therefore, amended claims 9, 30, and 38 are allowable for at least the same reasons discussed above. Notice to that effect is respectfully requested.

(2) The Action rejected claims 2, 3, 8, 10, 11, 16, 17, 31, 32, 37, 39, 40, and 45 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of U.S. Publication No. 2005/0188307 to Bailey, *et al.* (hereinafter *Bailey*). Applicants respectfully traverse the rejections.

*Bailey* is assigned to MICROSOFT CORPORATION OF REDMOND, WA, which is the assignee and owner of the present application as well. Therefore, *Bailey* is disqualified as prior art under 35 U.S.C. § 103(c) because of common ownership. Therefore, claim 17 is in condition for allowance.

Claims 2, 3, and 8 depend from amended independent claim 1; claims 10, 11, and 16 depend from amended independent claim 9; claims 31, 32, and 37 depend from amended independent claim 30; and claims 35, 40, and 45 depend from amended independent claim 38. Thus, dependent claims 2, 3, 8, 10, 11, 16, 31, 32, 37, 39, 40, and 45 are allowable for at least the same reasons discussed above with respect to amended claims 1, 9, 30, and 38. Therefore, based

on the foregoing, the rejection of claims 2, 3, 8, 10, 11, 16, 17, 31, 32, 37, 39, 40, and 45 should also be withdrawn.

(3) The Action rejected claims 4-6, 12-14, 34, 35, and 41-43 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of U.S. Patent No. 6,570,582 to Sciammarella, *et al.* (hereinafter *Sciammarella*). The rejections are respectfully traversed.

*Sciammarella* discloses a method and system for displaying images on a screen. According to *Sciammarella*, a temporal order of the images is determined first, and one of them is designated as a first image. The images are then displayed sequentially in temporal order such that the first image has the largest size among the displayed images. (*Sciammarella*, Abstract and col. 2, lines 18-24) Thus, *Sciammarella*, individually or in combination with *Giroux* or *Nolan*, does not teach or suggest any of the elements of amended independent claims 1, 9, 30, or 38 as discussed above.

Claims 4-6 depend from amended independent claim 1; claims 12-14 depend from amended independent claim 9; claims 34 and 35 depend from amended independent claim 30; and claims 41-43 depend from amended independent claim 38. Thus, dependent claims 4-6, 12-14, 34, 35, and 41-43 are allowable for at least the same reasons discussed above with respect to amended claims 1, 9, 30, and 38. Therefore, based on the foregoing, the rejection of claims 4-6, 12-14, 34, 35, and 41-43 should also be withdrawn.

(4) The Action rejected claims 7, 15, 36, and 44 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of U.S. Patent No. 5,940,800 to Bennett, *et al.* (hereinafter *Bennett*).

*Bennett* discloses attorney terminals which operate using an outline for storing, associating, and managing case evidence, case law, and work product for a given lawsuit at issue. (*Bennett*, Abstract and col. 3, lines 24-34) Thus, *Bennett*, individually or in combination with *Giroux* or *Nolan*, does not teach or suggest any of the elements of amended independent claims 1, 9, 30, or 38 as discussed above.

Claim 7 depends from amended independent claim 1; claim 15 depends from amended independent claim 9; claim 36 depends from amended independent claim 30; and claim 44 depends from amended independent claim 38. Thus, dependent claims 7, 15, 36, and 44 are allowable for at least the same reasons discussed above with respect to amended claims 1, 9, 30, and 38. Therefore, based on the foregoing, the rejection of claims 7, 15, 36, and 44 should also be withdrawn.

(5) The Action rejected claims 18-21, 23-27, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of *Bailey* in further view of *Sciammarella*.

Independent claim 17 recites, inter alia, “determining each of the format attributes associated with a region of content of the electronic document, wherein the region of content comprises a portion of content to be placed in another location of the electronic document”, “determining if any of the portion of content to be copied contains direct formatting attributes”, and “recording the format attributes and the direct formatting attributes associated with the portion of content.”

Independent claim 23 includes features similar to those recited in amended claim 1. In addition claim 23 recites “determining if any of the portion of content contains direct formatting attributes” and “applying the direct formatting attributes to the portion of content based on the first set of format attributes and the second set of format attributes in response to pasting the portion of content at the location.” Definitions of and differences between local and direct formatting are described in the Specification (e.g. pages 20 and 21). Thus, none of *Giroux*, *Nolan*, *Bailey*, *Sciammarella*, individually or in combination, teach or suggest the features of independent claims 17 and 23.

Claims 18-21 depend from independent claim 17; claims 24-27 and 29 depend from independent claim 23; and claim 33 depends from amended independent claim 30. Thus, dependent claims 18-21, 24-27, 29, and 33 are allowable for at least the same reasons discussed

above with respect to amended claims 17, 23, and 30. Therefore, based on the foregoing, the rejection of claims 18-21, 23-27, 29, and 33 should also be withdrawn.

(6) The Action rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of *Bailey* in further view of *Bennett*.

Claim 22 depends from independent claim 17. Thus dependent claim 22 is allowable for at least the same reasons discussed above for independent claim 17. Notice to that effect is respectfully requested.

(7) The Action rejected claim 28 under 35 U.S.C. § 103(a) as being unpatentable over *Giroux* in view of *Nolan* in further view of *Bailey* in further view of *Sciammarella* in further view of *Bennett*.

Claim 28 depends from independent claim 23. Thus dependent claim 28 is allowable for at least the same reasons discussed above for independent claim 23. Notice to that effect is respectfully requested.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that the present application is in condition for allowance. Reconsideration and reexamination of the application and allowance of the claims at an early date are hereby solicited. If the Examiner has any questions or comments concerning this matter, the Examiner is invited to contact the applicant's undersigned attorney at the number below.

Respectfully submitted,

MERCHANT & GOULD, LLC



Date: June 18, 2007

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